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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,803	01/24/2002	Anthony Jabar JR.	099505 /51061	9378

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NIXON PEABODY LLP
101 Federal Street
Boston, MA 02110

EXAMINER
GRUNBERG, ANNE MARIE

ART UNIT	PAPER NUMBER
1661	8

DATE MAILED: 08/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/056,803	JABAR ET AL.	
	Examiner	Art Unit	
	Anne Marie Grunberg	1661	

-- The MAILING DATE of this communication appears on the cover sheet with the corresp ndence address --

P riod for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *30 April 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1-3 and 7-12* is/are rejected.

7)☐ Claim(s) *4-6 and 13-20* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

The previous Office action dated 7/15/03 has been vacated in favor of the following rejection.

The Group and/or Art Unit location or your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1661.

Election/Restrictions

Acknowledgement is made of Applicant's election without traverse of Group I, drawn to a method of increasing crop yield. Upon further consideration however, all claims previously withdrawn from consideration under 37 CFR 1.142 have been rejoined and the restriction requirement made in Paper No. 5 is hereby withdrawn.

Claim Objections

Claims 4-6 and 13-20 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. Alternatively, the claims are dependent on claims that are improper multiple dependent claims, or are dependent on other multiple dependent claims. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claims 1-3 and 7-12 have been examined on their merits.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/150,500. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are each drawn to methods using a composition comprising a peptide and a polysaccharide wherein the peptide is present in an amount of 2-90% by weight of the dry weight of the total peptide-polysaccharide complex and the polysaccharide is present in an amount of 10-98% by weight of the dry weight of the peptide-polysaccharide complex.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 recite the limitation "said crop" in lines 2 or 3. There is insufficient antecedent basis for this limitation in the claims. The recitation "crop" does not equate to "crop yield", "crop emergence", or "crop maturity" as in the latter cases, "crop" is used as an adjective.

Claim 8 recites the limitation "the total peptide-polysaccharide complex" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1-3 and 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Cottrell et al.

The claims are drawn to a method of increasing crop yield, and accelerating crop emergence and crop maturity or a seed composition whereby an effective amount of a composition comprising a peptide and a polysaccharide is administered to soil wherein the peptide is present in an amount of 2-90% by weight of the dry weight of the total peptide-polysaccharide complex and wherein the polysaccharide is present in an amount of 10-98% by weight of the dry weight of the peptide-polysaccharide complex.

Cottrell et al teach a composition and methods of using a composition comprising a peptide (soy protein for example – last two lines of claim 21) and a polysaccharide (cellulose – claim 19 for example) that may be administered to soil (column 9, lines 43-56; claim 25; column 3, line 21; and column 8, lines 57-58, for example) wherein the amount of peptide and the amount of polysaccharide present is not critical (column 7, lines 8-21; column 8, lines 38-41; for example) and as such encompasses the broad ranges claimed in the claims. Methods of increasing crop yield, accelerating crop emergence and crop maturity are taught in column 9, lines 43-56 where the use of plant growth accelerator, soil improvement agent, seed coating, and seed germination are discussed.

2. Claims 1-3 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by A.W. Morgan.

The claims are drawn to the subject material described previously.

Morgan teaches a composition and methods of using a composition comprising a peptide (casein in milk, wheat gluten in flour, for example – column 3, line 6; column 10, Table 5A; column 14, Example 13, for example) and a polysaccharide (cellulose from

shredded newspaper or corn starch for example – column 4, lines 5-7; column 13, Table 11A; for example) that may be administered to soil (column 6, lines 9-34, for example) wherein the amount of peptide and the amount of polysaccharide present varies depending on the formulation used, but which for example may be greater than 2.5%-97% (see column 12, table 9A, for example) and as such encompasses the broad ranges claimed in the claims. Administering the composition after seeding of the crop is taught at column 8, lines 36-40, for example. Methods of increasing crop yield, accelerating crop emergence and crop maturity are taught in column 7, lines 1-56, for example. However, it is noted that the preamble does not carry patentable weight and as such, even if these methods were not explicitly taught in the prior art, the lack of such would not be accepted as a persuasive argument of overcoming the prior art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 10-12 are r jected under 35 U.S.C. 103(a) as being unpatentable over Cottrell et al. in view of Stewart et al.

Claims 10-12 are dependent on claim 8 discussed above (under the 102(b) rejection). In addition to the above-described composition, the crop seeds specified in claims 10-12 are potato seeds, or a grain such as barley.

Cottrell et al, in relation to the composition has been discussed *supra.*

Cottrell et al does not specifically teach potato seeds or barley grain.

Stewart et al teach a seed protective coating for potato seeds and barley (column 14, lines 31-36, for example).

It would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to use the composition taught by Cottrell et al and to coat seeds as taught by Cottrell et al, including potato and barley seeds as specifically pointed out by Stewart et al. given that potato seeds and barley seeds are commonly coated in agronomic practice.

Summary

No claim is allowed.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne Marie Grünberg whose telephone number is (703) 305-0805. The examiner can normally be reached from Monday through Thursday from 7:30 until 5:00, and every other Friday from 7:30 until 4:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Bruce Campell, can be reached at (703) 308-4205. The fax number for the unit is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

ANNE MARIE GRUNBERG
PATENT EXAMINER